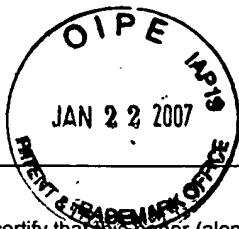


PATENT



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Date: January 19, 2007

Michele Muller

(Name of person mailing paper)

Michele T. Muller

(Signature of person mailing paper)

Attorney Docket No. FR-AM1888NP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PRADEL, Jean-Laurent, et al

Group Art Unit: 1772

Serial No.: 10/671,758

Examiner: PATTERSON, Marc A

Filed: September 26, 2003

For: " COEXTRUSION TIE FOR POLYESTER BASED ON COGRAFTED METALLOCENE
POLYETHYLENE AND LLDPE AND ON METALLOCENE POLYETHYLENE "

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief dated January 11, 2007, Applicant files the following Amended Appeal Brief containing all of the items required under 37 CFR 41.37(c) under the proper headings and in the proper order.

Applicant filed a Notice of Appeal pursuant to 37 C.F.R. §1.191 on September 26, 2006 along with a Pre-Appeal Brief Request for Review. Applicant filed an Appeal Brief, authorization and fee in duplicate pursuant to 37 C.F.R. §1.17(c) on November 27, 2007, which was determined to be non-compliant. The amended brief is being filed in triplicate.

I. Real Party in Interest

The real Party in interest, as evidenced by the assignment document Reel/Frame 014595/0836 recorded May 4, 2004.

II. Related Appeals and Interferences

There are no other appeals or interferences known to Appellant which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-10, and 12-14 are pending. Claims 1-10, and 12-14 stand rejected and are being appealed. Claim 11 has been canceled without prejudice or disclaimer. A copy of the claims as currently pending is found in the Claims Appendix.

IV. Status of Amendments

All proposed amendments have been entered. No amendments were presented after final rejection.

V. Summary of Claimed Subject Matter

The question raised on appeal is not directly related to any specifically claimed subject matter of the application.

Independent claim 1 relates to a coextrusion tie layer which adheres to polyester, and which is a blend of ungrafted metallocene polyethylene with a blend of cografted metallocene polyethylene and cografted non-metallocene linear low density polyethylene. It is fully supported by original disclosure in the Substitute Specification on Page 3, Lines 7 – 29.

Independent claim 6 relates to a multi-layer structure in which the coextrusion tie of claim 1 is attached directly to a polyolefin or polyester layer. The claim is fully supported by original disclosure on Page 4, Lines 6-10 of the Substitute Specification.

Independent claim 9 relates to an object incorporating the multi-layer structure of claim 6. The claim is fully supported by original disclosure on Page 4, Lines 19-21 of the Substitute Specification.

VI: Grounds of Rejection to be Reviewed on Appeal

The single issue on Appeal is:

Once a proper terminal disclaimer has been accepted by the USPTO, can the Examiner then effectively nullify said terminal disclaimer by citing as a substitute reference a foreign equivalent of the US terminally disclaimed case?

VII: Argument

All pending- claims 1-10, and 12-14 are argued as a single group and are to stand or fall together.

KEY FACTS:

Present application prosecution History:

09/27/2002 - FR 02.11992 application was filed in France as the priority document.

09/26/2003 – US patent application 10/671,758 was filed, claiming priority to FR 02.11992.

02/08/2005 – First Office Action Rejection: §112 and double patenting rejections over US 6,528,587 in view of X, as the only rejections.

4/29/2006 – A response and terminal disclaimer over US 6,528,587 with proper fees was filed.

7/26/2005 – Non-final rejection: over EP 1136536 (EP equivalent of terminally disclaimed US 6,528,587) using US 6,528,587 as the translation!

10/25/2006 – Response, claiming that a citation of the EP equivalent of the terminally disclaimed US case as prior art is improper.

01/12/2006 – Non-final rejection: over same EP 1136536 art.

06/12/2006 – Response (with 1-month extension fee) again arguing improper citation of the European equivalent of the US terminally disclaimed patent.

07/26/2006 – Final rejection, again based on EP 1136536.

09/26/2006 – A Notice of Appeal and Pre-Appeal Brief Request for Review was filed.

11/03/2006 – Notice of the Panel Decision to proceed to the Board of Patent Appeals

Prosecution history of US 6,528,587 and European equivalent EP 1136536

03/24/2000 – FR 0003797 was filed.

03/16/2001 - EP 1,136,536 B1 was filed. Published September 26, 2001, claiming priority to the FR 0003797 priority document.

03/26/2001 - US 6,528,587 B2 filed (first business day – Monday – after the 1-year anniversary of the priority document), and published December 20, 2001, claiming priority to the FR 0003797 priority document.

03/04/2003 – US 6,528,587 granted.

The Examiner erred in applying the EP equivalent patent of a US terminally disclaimed patent, in substitution for said US terminally disclaimed patent.

Applicant contends that application of a foreign equivalent after the acceptance of a terminal disclaimer of the US case:

- A. Is against the stated purpose of a Terminal disclaimer.**
- B. Is against public policy.**
- C. Is against international treaties.**
- D. Is against US Examination Procedure of Piecemeal Examination**
- E. Allows the Examiner to obtain a terminal disclaimer, then turn around and substitute the foreign equivalent of the disclaimed patent, making a mockery of the terminal disclaimer and Examination process.**
- F. Would lead to the invalidation of many current US patents.**
- G. Could provide a means for the US Patent Office to change established policy and limit terminal disclaimers, thus more closely matching International Patent Practice.**

Applicant knows of no case law on point.

Applicant acknowledges that the EP 1136536 application, published one year and one day before Applicant's priority document, could be a valid prior art reference.

Applicant notes that the Examiner in this case recognizes the equivalence of the US 6,528,587 and EP 1136536 documents – since the Examiner uses the US patent as the English

translation of the EP application. The US '587 and EP '536 equivalent patents of course have the same priority document with a date of March 24, 2000.

A. Is against the stated purpose of a Terminal disclaimer:

If a terminal disclaimer over a US patent is not also a terminal disclaimer over all foreign equivalent cases having the same priority date, then the terminal disclaimer ceases to function in the manner anticipated by the law. The main function of the Terminal Disclaimer is that it obviates the primary objection to double patenting, which is the extension of monopoly. *In re Robeson*, 331 F.2d 610, 141 USPQ 485 (1964). To accomplish this purpose, the terminal disclaimer should place the claims in the same position with respect to the EP ('536) subject matter as the US ('587). Since the present claims now terminate with the US ('587) patent claims, there is no monopoly extension over either US ('587) or the equivalent (EP '536).

The effect of a terminal disclaimer is to tie the affected patents together [*Ortho Pharmaceutical Corp v. Smith*, 959 F.2d 936, 22 USPQ 2d 1119, 1123 (Fed. Cir 1992)]. Tying the US patent, without also tying all foreign equivalent applications having the same priority, produces an incomplete tying, thus frustrating the purpose of the terminal disclaimer.

Further, it could flow from the tying to the terminal date of a new US application to the terminal date of an earlier filed US patent that the same new US application would have an effective priority of the earlier filed US patent – perhaps not generally, but at least as related to foreign equivalents of the earlier US case.

B. Is against public policy:

One important public policy purpose of a Terminal Disclaimer is that improvements are placed into the public domain sooner. In this regard, the framers of the present regulations placed no limits on length of time that can be terminally disclaimed. The effect of the Examiner's substitution of a foreign equivalent for a terminally disclaimed US patent will be to limit the use of a terminal disclaimers to applications that have not published in a foreign office more than one year before the filing of the application at bar.

The effect of a terminal disclaimer that applies only to the US patent, and not to any foreign equivalents, in effect limits the use of a terminal disclaimer for any internationally filed patent, to US cases filed less than 30 months prior to the application filing date. Foreign patent

applications publish at 18 months, making the disclaimer of any US patent older than 30 months and filed internationally a useless exercise (18 months to publish, and must publish more than 12 months before US case). This allows Patent Examiners an opportunity to effectively nullify any Terminal Disclaimer of an internationally filed US patent older than 30 months by citing the foreign equivalent as prior art as a substitute.

The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. MPEP 804.02(II). *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

C. Is against international treaties:

The Paris Convention, in Article 4 (A) (2) provides that “Any filing that is equivalent to a regular national filing...be recognized as giving rise to the right of priority”. For references filed under the PCT, then by 35 U.S.C. §102(e) and §103(a) any international application shall have the effects of an application filed in the US. Since PCT applications are given the same effect as US references under 35 U.S.C. §102(e), then it would follow that the same effect should apply to a terminal disclaimer over a PCT application.

Since international patent applications share priority date status by treaty, it would make sense that the terminally disclaimed US patent should also share removal as references international patent equivalents of the disclaimed US patent.

D. Is against US Examination Procedure of Piecemeal Examination:

MPEP 707.07(g) provides that piecemeal examination should be avoided. Once a rejection over a prior art reference has been overcome, the citation of the same reference, only filed in a different country, amounts to an undue, burdensome, replicate piecemeal examination that does not further the patenting process.

E. Allows the Examiner to obtain a terminal disclaimer, then turn around and substitute the foreign equivalent of the disclaimed patent, making a mockery of the terminal

disclaimer and Examination process. A foreign equivalent of a US Terminally-disclaimed reference (with the same priority date) should not be allowed to be used as a substitute 35 U.S.C. §103 reference. The substitute of equivalent references makes a mockery of US Terminal Disclaimer practice, allowing Examiners to circumvent most Terminal Disclaimers. Once a US applicant decides to shorten the length of monopoly protection in exchange for removal or a prior art reference it is unfair for the Patent office to accept such a terminal disclaimer, then use a foreign equivalent patent to make the same arguments. This would amount to a Government taking of Applicant's property rights through trickery, and without any consideration.

F. Would lead to the invalidation of many US patents


Many currently granted US patents have been allowed with terminal disclaimers to obviate prior art. Any of these granted US patents in which the terminally disclaimed patent was foreign published prior to the invention, could now be rendered invalid over the foreign equivalent patent. Applicant is concerned that this change of USPTO policy could cause havoc with several **of Applicant's granted US patents, and cause a general crisis for many other patent holders.**

H. Could provide a means for the US Patent Office to change established policy and limit terminal disclaimers, thus more closely matching International Patent Practice. The terminal disclaimer is unique to US patent practice. As the US strives for harmonization with world patent practices, limitation of terminal disclaimer practice in which foreign equivalent patents can be substituted for a terminally disclaimed patents would be a large first step toward the elimination of the terminal disclaimers altogether. If this is the goal of the new terminal disclaimer policy which is the subject of the present application reject and Appeal, then Applicant would encourage the USPTO to more clearly state this new policy.

CONCLUSION

Appellant submits that the substitution of a foreign equivalent patent as a 35 USC §103(a) reference for a terminally disclaimed US patent is improper and unfair. The rejection of record should not be sustained, and the Board is requested to reverse the Examiner's rejection.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Thomas F. Roland".

Thomas F. Roland

Reg. No. 42,110

Date: January 18, 2007

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VIII: CLAIMS APPENDIX

Claims as they currently stand

1. A coextrusion tie, which comprises:

- 5 to 35% by weight of a polymer (A) itself composed of a blend of 80 to 20% by weight of a metallocene polyethylene (A1) with a density of between 0.863 and 0.915 and of 20 to 80% by weight of a non-metallocene LLDPE polyethylene (A2) with a density of between 0.900 and 0.950, the blend of polymers (A1) and (A2) being cogenerated by a grafting monomer chosen from unsaturated carboxylic acids and their derivatives, the content of the grafting monomer in said blend being between 30 and 100 000 ppm, preferably between 600 and 5 000 ppm;
- 95 to 65% by weight of metallocene polyethylene (B) homo- or copolymer, the comonomer of which comprises 3 to 20 carbon atoms, the density of which is between 0.863 and 0.915 and the MFI, melt flow index, of which, measured under 2.16 kg at 190°C according to Standard ASTM D 1238, is between 0.5 and 30, g/10 min;

the total forming 100%, the blend of (A) and (B) being such that its MFI is between 0.1 and 15, g/10 min.

2. The tie as claimed in claim 1, the adhesive strength of which is increased by 5 to 50% between the time $t=0$ corresponding to its application immediately after its extrusion and the time $t=8$ days.
3. The tie as claimed in claim 1, wherein the grafting monomer is maleic anhydride.
4. The tie as claimed in claim 1, which additionally comprises an ethylene/alkyl (meth)acrylate copolymer (C).
5. The tie as claimed in claim 1, wherein the MFI of A is between 0.1 and 5 g/10 min (ASTM D 1238 at 190°C under 2.16 kg).

6. A multilayer structure, which comprises a layer (L) comprising the tie of any one of the preceding claims and a layer (E) directly attached to one of the two faces of said layer (L), said layer (E) being a polyolefin or polyester layer.
7. The multilayer structure as claimed in claim 6, wherein a layer (F) is directly attached to the second face of the layer (L), the layer (L) being sandwiched between the layers (E) and (F), said layer (F) being either a polymer layer, the polymer being chosen from the group of the polyamides, saponified copolymers of ethylene and of vinyl acetate (EVOH), polyolefins and polyesters, or a metal layer.
8. The multilayer structure as claimed in claim 7, wherein the layer (E) is a polyester copolymer layer and the layer (F) is an EVOH layer.
9. An object, which comprises a structure as claimed in claim 6.
10. The object as claimed in claim 9, which is a bag, a bottle, a container, a film, a sheet, a pipe or a hose.
11. (canceled)
12. The coextrusion tie of claim 1 wherein said metallocene polyethylene (B) copolymer comonomer comprises 4 to 8 carbon atoms.
13. The coextrusion tie of claim 1 wherein said metallocene polyethylene (B) has an MFI, melt flow index, of which, measured under 2.16 kg at 190°C according to Standard ASTM D 1238, is between 3 and 15, g/10 min.
14. The coextrusion tie of claim 1 wherein the blend of (A) and (B) being such that its MFI is between 1 and 13 g/10 min.

IX: EVIDENCE APPENDIX

No evidence under §§ 1.130, 1.131, or 1.132 was entered in this application.

X: RELATED PROCEEDINGS APPENDIX

No related proceeding were identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. §41.37.